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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,709	08/31/2000	Oscar Lee Avant	08049.009	3489
22852	7590	02/04/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			SCHLAK, DANIEL K	
			ART UNIT	PAPER NUMBER
			3653	

DATE MAILED: 02/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/652,709	AVANT ET AL.
	Examiner	Art Unit
	Daniel K Schlak	3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 November 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-158 is/are pending in the application.
- 4a) Of the above claim(s) 9-76,83-90 and 97-158 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8,77-82 and 91-96 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 20 | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Claims 9-76, 83-90, and 97-158 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Groups II, III, IV, V, VI, VII, and VIII, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 23.

Claim Objections

Claim 1 is objected to because of the following informalities: in line 12 of the amended claim is to be found the recitation “processing sorting the mailpiece...” It is clear that the word “sorting” should have been deleted via the amendment. Appropriate correction is required.

Claim 4 is objected to because of the following informalities: the claim recites that the “postal is a POSTNET code” The Examiner believes the word “code” has been omitted between “postal” and “is”. Appropriate correction is required.

Claim 77 is objected to because of the following informalities: line 15 of the claim recites “the mailpiece include neither...” The word “include” should be changed to “includes” to conform in tense with its singular subject. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 77, and 91 (and thus 2-8, 78-82, and 92-96 by dependency) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite for failing to specify the nature of the "code" which is to be found on the mailpieces.

The claims are indefinite for failing to specify the nature of the "front" and the "back" of the mailpieces.

In a broad interpretation, the term "code" refers to any data that could be found on a mailpiece. This is to include handwritten address data, machine-printed address data, zip code, bar code, or any of the codes offered in claims 2-8, etc.

In such a broad interpretation, the claims rejected here become a contradiction in terms. In a modern environment such as the one in which the instant application pertains, all incoming mailpieces are to have an address written or printed on the "front". The "front" of a mailpiece is the face wherein resides the address. Therefore, there is a code on the "front" of every incoming mailpiece, whether the code consists solely of a person's name and a street address, or the code consists of various postal-system specific bar-codes and markings. In this interpretation, it can never be inferred that "the front" of the mailpiece has no code. Therefore, the determination of "if" the mailpiece

includes a code on the front is moot and the determination that there is a code on the "back of the mailpiece only" is impossible.

For example, if one were to envision a typical string of mailpieces being handled by the method set forth in the independent claims herein discussed. The first one has an address hand-written on its front, and a POSTNET code imprinted on its back. According to the specification of the instant application, it would be sorted using the POSTNET code on the back. But, as the first mailpiece had an address written on the front, it had a code on the front, but was sorted based only upon the code on the back. The handling of the first mailpiece has shown itself to be not within the scope of the independent claims. Since it had a code on the front, it should have been, according to claims 1, 77, and 91, sorted based upon the code on the front.

Following the above example, a second mailpiece comes in with a handwritten code with illegible zip code on the front, and a bar code on the back that was put there by a foreign post office and cannot be read by the apparatus used for implementation of the methods of claims 1, 77, and 91. The second mailpiece will be processed in the identification code system, will have applied thereto an ID code on its back and a postal code on its front, and an identification file created therefore, while it is clear from the definition of the scenario that the second mailpiece did indeed have a code on the front and a code on the back upon receipt of the second mailpiece, but was not treated according to the first condition of claims 1, 77, and 91, and therefore not within the scope of the claims. A mailpiece came in which did indeed have a code on the front,

but it was not sorted using the code on the front, as per the recitations of claims 1, 77, and 91, and therefore the claim contradicts its own conditions in a very real application.

Further, the ambiguity and conditionality of the claims leaves them open for application of any number of references that do or do not have pertinence to the instant application. The Examiner has made no art rejections, because the claims cannot in any sense be applied to any real-world application. In every application known to the Examiner, all incoming mail will have an address on one side, which side is by definition is a "code" on the "front" of the mailpiece, and therefore will be at some point sorted according to said code on said front. The remaining subject matter of each of the claims is in this case moot as being outside of the scope of the first condition set forth in the claims.

Further, any of a number of mail sorting systems, some dating back to the 1930's, which accepts mailpieces, faces them, and sorts them, reads on claims 1, 77, and 91 because the "facing" procedure is inherently a determination of which side has the best "code" for sorting, and the incoming articles will have already been depleted of all mailpieces having both faces completely blank – the definition of "neither a code on the front... nor... on the back" – and therefore the third condition will not exist, the system happily operating upon the first two conditions, and therefore the third condition becomes moot as not applying to any realizable scenario. In other words, if blank mailpieces never come in, then they are never dealt with at all, and therefore no mailpieces are ever determined to have no code on the front and no code on the back, and therefore the third condition never comes into play, and therefore the answer to "if"

is always "no" and the claim is anticipated as bringing in an activity that is in response to a condition which never arises.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel K Schlak whose telephone number is 703-305-0885. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306 - 4173. The fax phone number for the organization where this application or proceeding is assigned is 703-306-4195.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308 - 1113.

dko


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